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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,238	10/12/2001	David A. Basiji	BIOL0029	9708

25268 7590 11/07/2002

LAW OFFICES OF RONALD M ANDERSON
600 108TH AVE, NE
SUITE 507
BELLEVUE, WA 98004

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

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DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,238

Applicant(s)

BASIJI ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, and 8-12, drawn to a method of constructing a library of optically distinct reporter labeled carriers, classified in class 436, subclass 518.
 - II. Claims 3-7, drawn to a method of constructing a library of uniquely identifiable reporters suitable for labeling beads, classified in class 435, subclass 174.
 - III. Claims 13-18, drawn to a method of constructing an optically discriminable reporter that is distinguishable by a specific imaging system, classified in class 436, subclass 164.
 - IV. Claims 19-23, drawn to a method of constructing a plurality of reporters, classified in class 436, subclass 523.
 - V. Claims 24-33, drawn to a method of preparing a library of diverse compounds, classified in class 435, subclass 4.
 - VI. Claims 34-36, drawn to a method of preparing a library of diverse compounds by step-wise synthesis, classified in class 436, subclass 8.
 - VII. Claims 37-39, drawn to a method of preparing a library of different compounds by step-wise synthesis, classified in class 435, subclass 180.
 - VIII. Claim 40, drawn to a method of constructing an optically discriminable reporter that is distinguishable by a specific imaging system with aggregate reporter, classified in class 436, subclass 169.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, II, III, IV, V, VI, VII, and VIII are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions the different inventions as claimed have different method steps that have different functions and modes of operation.

The method step of attaching the reporter to the carrier in each reaction vessel of Group I is not required by the claims of Groups II-VIII. The method step of determining a number of unique reporters required to completely encode a desired bead library of Group II is not required by the claims of Groups I, and III-VIII. The method step of combining a plurality of singly labeled microparticles together to generate an aggregate reporter of Group III is not required by the claims of Groups I-II, and IV-VIII. The method step of repeating in a stepwise fashion until each reaction vessel contains an aggregate of singly labeled microparticle of Group IV is not required by the claims of Groups I-III, and V-VIII. The method step of pooling contents from each reaction vessel to form a common pool of Group V is not required by the claims of Groups I-IV, and VI-VIII. The method step that include identical second components being added to each reaction vessel that contains the identical type of optically distinct carrier of Group VI is not required by the claims of Groups I-V, and VII-VIII. The method step of exposing the plurality of carriers to a plurality of first components of Group VII is not required by the claims of Groups I-VI, and VIII. The method step that include the aggregate reporter being optically distinguishable by the specific imaging system in response to an optical characteristic of the

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aggregate reporter other than size and shape of Group VIII is not required by the claims of Groups I-VII.

3. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the method step of combining a plurality of singly labeled microparticles together to generate an aggregate reporter while a patentability determination for Group V would involve a consideration of the patentability of the method step of pooling contents from each reaction vessel to form a common pool. These considerations are very different in nature.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
November 3, 2002


PADMASHRI PONNALURI
PRIMARY EXAMINER